

Application No. 10/615,614  
Election With Traverse dated January 12, 2005  
Reply to Restriction Requirement of December 15, 2004  
Attorney Docket No. 644-031014



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/615,614 Confirmation No. 8274  
Applicants : Michael A. Funari et al.  
Filed : July 8, 2003  
Title : FLUSH VALVE DIAPHRAGM ORIFICE INSERT  
AND RIB DESIGN  
Group Art Unit : 3751  
Examiner : J. Casimer Jacyna  
Confirmation No. : 8274  
Customer No. : 28289

MAIL STOP AMENDMENT  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

ELECTION WITH TRAVERSE

Sir:

This is in response to the Office Action dated December 15, 2004 in which the Examiner required restriction to one of the following inventions:

Invention Group I, covering claims 1-6 and 21, drawn to a filter insert;  
Invention Group II, covering claims 7-11, drawn to a diaphragm; and  
Invention Group III, covering claims 12-20, drawn to a flush valve.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 12, 2005.

Helen Gerace  
(Name of Person Mailing Paper)

Helen Gerace  
Signature

January 12, 2005  
Date

Applicants hereby elect for further prosecution Invention Group II, covering claims 7-11, drawn to a diaphragm, with traverse for the reasons set forth below. Further, Applicants believe that Group II also includes claims 12-16 which are primarily directed to a flush valve diaphragm.

Applicants respectfully traverse the restriction requirement on the grounds that no serious burden exists on the Examiner by examining claims 1-21 in a single application. Enclosed herewith is U.S. Patent No. 5,213,305 to Whiteside et al. (hereinafter "the Whiteside patent"), entitled "Bypass Orifice Filter For Flush Valve Diaphragm." The Whiteside patent not only is in the same field of technology as the present invention, but is directed to substantially the same subject matter. For example, the claims of the Whiteside patent are directed to a bypass orifice and filter means (claims 1-10), a diaphragm assembly (claims 11-12) and a flush valve (claim 13). The classes and subclasses identified in the present application are also identified on the face of the Whiteside patent. Although Applicants' counsel is aware that Examiners do not have to follow another Examiner's decision not to restrict claims, we believe the Whiteside patent provides strong evidence to support a claim that no serious burden exists on the Examiner in examining claims 1-21 in a single application. Therefore, reconsideration and withdrawal of the restriction requirement is respectfully requested.

Even if the Examiner does not agree to examine all of the claims in a single application, the examination of the claims of the inventions of Group II (claims 7-11) and Group III (claims 12-20) does not constitute an undue burden. Further, claims 12-16 are directed to a flush valve diaphragm assembly that constitutes a flush valve diaphragm and an insert. Therefore, claims 12-16 should be classified in Group II, not Group III. In order to substantiate a claim of undue burden, the Examiner must show the existence of one of the following reasons: (1) separate classification of the subject matter of the inventions, as set forth in the Manual of Classifications; (2) separate status in the art when the subject matter of inventions is classified together; and (3) a different field of search for the subject matter of the inventions. *See MPEP § 808.02.* The Examiner has not satisfied that the examination of the inventions of Groups II and III (claims 7-20) constitute an undue burden for the following reasons: First, the inventions of Groups II and III have the same classification (i.e., Class 251) for searching purposes and, therefore, would not require a separate field of search. Secondly, the subject matter of the inventions of Groups II (i.e.,

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flush valve diaphragm) and III (i.e., flush valve) have not obtained a separate status in the art as evidenced by the following patents. Enclosed herewith is U.S. Patent No. 6,299,128 to Verdecchia, wherein the claims are directed to both a flush valve diaphragm assembly (claims 1-13) and a flush valve (claims 14-28). Also enclosed is U.S. Patent No. 4,327,891 to Allen et al., wherein the claims are directed to a flush valve (claims 1-14) and a diaphragm (claims 15-20). The above patents substantiate the fact that the subject matter of the inventions of Group II (diaphragm) and Group III (flush valve) have the same status in the art. Because the inventions of Group II and III have the same classification and the same field of search, there is no clear indication of a serious burden on the United States Patent and Trademark Office. In view of the above, no serious burden exists on the Examiner by examining claims 7-20 in a single application. Further, under the present restriction requirement claims 12-16 should have been placed in Group II, therefore, at a minimum, claims 7-16 should be examined. Accordingly, if the Examiner does not agree to the examination of all the claims as discussed above, withdrawal of the restriction requirement in part is respectfully requested.

Applicants hereby reserve the right to prosecute non-elected claims 1-6 and 12-21 by way of a divisional application filed at a later time. Pursuant to 37 C.F.R. § 1.48(b), there is no change in inventorship as a result of this Election.

Respectfully submitted,

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By



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